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10/532,085

04/21/2005

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EXAMINER

CORDRAY, DENNIS R

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/532,085 | Applicant(s) SILENIUS ET AL. | |
| | Examiner DENNIS CORDRAY | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

SUPPLEMENTAL OFFICE ACTION

DETAILED ACTION

1. In response to the inquiry by Ron Kubovcik on December 29, 2009 regarding the Office Action prematurely mailed on July 27, 2009, which was during the requested period for a suspension of action that ended September 1, 2009, the Office Action is being remailed and a new time period for response started from the date of remailing.

Response to Arguments

2. Applicant's amendments and arguments filed 6/1/2009 have overcome the rejection of Claims 1-8 and 11 over WO 97/01670. The reference discloses a broad range of calcium carbonate to filler, 11.89 to 96.4%, but fails to disclose the claimed narrow range within which the air permeability does not substantially change with the amount of filler. The reference is thus not deemed to disclose the currently claimed range with sufficient specificity for anticipation. The rejection has been withdrawn.

In addition, all rejections over Claims 4-6 are withdrawn due to the cancellation of the claims.

The provisional obviousness-type double patenting rejection over copending Application No. 10/475774 is withdrawn due to abandonment of the application.

3. Applicant's arguments regarding the remaining rejections have been fully considered but they are not persuasive.

Silenius et al (WO 02/92909 and US 2004/0173329) disclose a preferred range for the amount of inorganic salt (e.g.-calcium carbonate) in proportion to filler of 60-80%, which encompasses and is slightly broader than the currently claimed range, and is deemed to be anticipatory. In addition, examples are presented in each reference of making a paper wherein the amount of calcium carbonate to filler is 69.7%, which lies within the claimed range. The filler content of the paper is 17.8% or 22.4%, and the amount of calcium carbonate is calculated to be 12.4 and 15.6% by weight of the paper, which lies within the claimed range (see '909, p 3, lines 27-31 and Examples 1 and 2, pp 8-9; '329, pp 1-2, par 19 and pp 3-4, pars 47-50).

The processes and fillers of the cited prior art are the same as the claimed process and fillers, and the papers formed will have substantially the same structure as the claimed paper and the claimed properties or, at least, obtaining the claimed properties would have been obvious to one of ordinary skill in the art because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent or at least obvious.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d

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1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

The rejections over the cited prior art are maintained but have been modified to include the claim amendments. In addition, a new provisional double patenting rejection is presented over recently published application 11/922575.

4. The double patenting rejections will remain on the record as presented until at least one of the current or copending applications has matured into a patent, or until a proper Terminal Disclaimer has been filed.

Claim Rejections - 35 USC § 102 and USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3, 7-9 and 11-15 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Silenius et al (WO 02/92909).

Silenius et al discloses method of making a paper or base web comprising adding a filler to a papermaking pulp, thus a paper comprising a base web and a filler is produced (p 4, line 26 to p 5, line 2). The filler comprises calcium carbonate, calcium oxalate, calcium sulfate or barium sulfate aggregates (inorganic salt particles)

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precipitated on cellulose fibrils from an aqueous solution (p 2, lines 12-16; p 3, lines 24-27). The filler comprises cellulose fibrils produced by refining cellulose fibers (plant fibers) and screening into a preferred screened fraction of from P100 -P400, or from 100 to 400 Mesh. Fibrils passing through a 100 Mesh screen will pass through a 50-Mesh screen. The fibrils have a thickness from 0.1-2 μm and a length from 10-400 μm (p 3, lines 13-23). The fibril dimensions significantly overlap the claimed dimensions.

Silenius et al discloses that the mass ratio of calcium carbonate to filler is preferably from 60-80% by weight, which encompasses and is slightly broader than the claimed range. The amount of filler used is 0.1-80% by weight of the paper (p 3, lines 27-31). In an example, a filler is made comprising 69.7% calcium carbonate, which lies within the currently claimed range (pp 8-9, Example 1). The composition significantly overlaps the claimed composition.

Paper is made comprising an amount of filler of Example 1 of 17.8% and 22.4%, or an amount of calcium carbonate of 12.4 and 15.6%, the amounts lying within the claimed range (p 9, lines 11-19, Example 2).

Silenius discloses that the paper can be coated with a layer having a weight of 5-30 gsm per side (p 5, lines 5-10; p 7, lines 20-22).

Silenius et al discloses that papers produced using the filler have better formation, retention, smoothness and a denser surface than when using commercial precipitated calcium carbonate. Other advantages disclosed include improved cost efficiency (p 2, lines 24-34).

While envelope paper is not explicitly disclosed by Silenius et al, it would have been obvious to one of ordinary skill in the art to make any kind of paper, including envelope paper, using the process to achieve the advantages disclosed by Silenius et al. Alternatively, any kind of paper can be made into an envelope.

The paper made by Silenius et al has a substantially identical structure to the paper made by the claimed process and will have the claimed air permeability because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

“[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

A rejection based on 35 U.S.C. 102(a) can be overcome by perfecting a claim to priority under 35 U.S.C. 119(a)-(d) by filing a certified priority document in the application and an English language translation, if the document is not in English and

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the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph.

6. Claims 1-9 and 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Silenius et al (US 2004/0173329).

Silenius et al (US 2004/0173329) discloses identical subject matter to Silenius et al (WO 02/92909), detailed in the previous rejection, thus the detail will not be repeated. The subject matter is disclosed on p 1, pars 9 and 14-19; p 2, pars 23-25; and p 3, pars 36, 4-50; p 4, par 50.

Making envelope paper would have been obvious to one of ordinary skill in the art for reasons given above.

The paper made will have the claimed air permeability also for reasons previously given.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3 and 7-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of the following copending Applications in view of *Silenius et al* ('909 or '329):

claims 12 and 16 of copending Application No. 10/475773;

claims 1 and 3-7 of copending Application No. 10/532481;

claims 16-22 and 24 of copending Application No. 11/808273;

over claims 1 and 6-9 of copending Application No. 11/922595.

Although the conflicting claims in each case are not identical, they are not patentably distinct from each other because the processes comprise adding the same filler to a papermaking slush. The copending claims do not recite the claimed range for the amount of calcium carbonate in the filler and in the paper. As discussed above, *Silenius et al* ('909 or '329) discloses making paper using the same filler and also disclosed preferred ranges for the amount of calcium carbonate in the filler and paper that are only slightly greater than the currently claimed range. In addition, *Silenius et al* discloses examples of fillers and papers having calcium carbonate in the claimed range. One of ordinary skill in the art to use the claimed ranges as a preferred range disclosed

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and exemplified by Silenius et al. The paper made by the method of the copending application will have the claimed air permeability for reasons given previously. Any paper can be made into an envelope, and making an envelope would have been an obvious use for the paper.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS CORDRAY whose telephone number is (571)272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Cordray/
Examiner, Art Unit 1791

/Eric Hug/
Primary Examiner, Art Unit 1791